

REMARKS

Reconsideration and allowance of the present application based on the following remarks are respectfully requested.

Upon entry of the above amendments, claims 2-3 and 9-25 will be pending in this application.

The claims are amended to expedite prosecution and place the application in condition for allowance.

Specifically, claim 1 is cancelled. Claim 2 is rewritten in independent form, adding a "proviso" as in the allowed claims of the commonly assigned copending related application SN 09/362,900, now U.S. 6,245,829. According to this proviso, when  $n = 1$ , the group Y represents the specified ester group. Such compounds are well within the disclosure of the invention.

The newly added claims generally correspond, but more clearly, to the original claims and are supported in the specification as originally filed. For example, reference is made to the disclosure on page 3, lines 8-11; page 5, lines 34-35; page 9, lines 11-16 and 25-27; page 10, lines 5-12; page 12, lines 10-12.

Accordingly, no new matter is added.

The following comments follow the objections and rejections in the order in which they appear starting on page 2 of the Office action.

The objection to the specification is noted. Applicants respectfully disagree.

Although the practitioner readily understands that WPU ("weight per unit") refers to the weight (grams) of polymer per mole of unsaturated group (obviously, "unsaturation, *per se*, cannot be measured in grams), nevertheless, as suggested by the Examiner, the pending claims now recite "grams of polymer per mole of unsaturated group."

Accordingly, the objection to the specification is moot.

Claim 1 is cancelled, therefore, the rejection under 35 USC 112, second paragraph is moot. However, it is noted that amended claim 2, re-written as an independent claim, recites "a radiation curable compound" thereby avoiding this potential rejection against claim 2.

Claim 2 continues to recite the polymer broadly. The specific polymer need not be recited as substantially any polymer P will work in the present environment. The Examiner is referred to the specification on pages 3, 4 and 5 for description of the broad ranges of representative polymers which may be used as polymer P.

Claim 4 is cancelled. Therefore the rejection under 35 USC 112, second paragraph is moot. However, it is noted that in the newly presented claim 9, directed to composition, the

polymer is in addition to the radiation curable compound. This is also clear in other claims which comprise the radiation curable compound and polymer. WPU has been discussed above.

The newly presented claims which recite a crosslinker specify the target for the crosslinker.

Since claim 6 is cancelled the rejection of this claim is moot. It is noted, however, that all of new claims 11-15 recite "powder paint compositions." All of these claims are dependent, directly or indirectly, on claim 2, and further limit claim 2 directed to radiation curable compound.

Accordingly, it is respectfully submitted that the amended and added claims are in full compliance with 35 USC 112, second paragraph.

Reconsideration of the rejection of Claims 1-8 as anticipated by Chevalier et al (US 5,360,836 or EP 0263749) is respectfully requested in view of at least the following comments.

In addition to the failure of Chevalier et al to disclose powder paint compositions (as in claims 11-15), there is only a disclosure of compounds with (activated) carboxylic acid unit next to hydrogen (see formula 1 of the reference in the Abstract and col. 2) hence, containing a urethane group. There is no disclosure of compounds which are mono- or multi-valent carboxylic acid esters of  $\alpha$ -,  $\beta$ -,  $\gamma$ -, or  $\delta$ -hydroxyalkylamide group containing compounds (the amide group having the formula, e.g., R<sub>3</sub>-C(=O)-NR<sub>1</sub>R<sub>2</sub>, wherein R<sub>3</sub> may be hydrogen or organic compound connected to the neighboring C via a carbon-atom bond.

Reacting an amide with  $\alpha,\beta$ -ethylenically unsaturated carboxylic acid will not result in a compound having an oxygen linkage to the adjacent R group.

Accordingly, the rejection of claims 1-8 as anticipated by Chevalier et al is respectfully traversed.

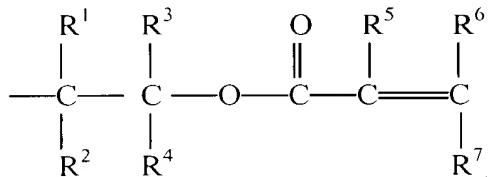
Reconsideration and withdrawal of the rejection of claims 1-8 as anticipated by Nason et al, U.S. 4,656,202, is requested for at least the following reasons.

Again, there is no disclosure of powder paint compositions (as in claims 11-15) nor is there a disclosure of radiation curable compounds having the structure as recited in claim 2. Here again, for example, the disclosed compounds have urethane linkages.

Accordingly, the rejection of claims 1-8 as anticipated by Nason et al is respectfully traversed.

The rejection of claims 1-8 as anticipated by Kelley (3,366,613) is respectfully traversed for at least the following reasons.

Radiation curable compounds are not disclosed by Kelley (Kelley's compounds are cured by baking). In addition, as specified in claim 2, when n = 1, Y = the group

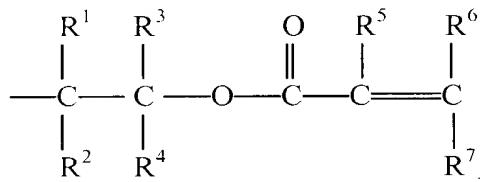


Compounds having this structure are not anticipated by Kelley.

Accordingly, withdrawal of this ground of rejection is requested.

Reconsideration and withdrawal of the rejection of claims 1-8 as anticipated by Kobayashi, U.S. 4,910,268, is requested for at least the following reasons.

Kobayashi does not disclose radiation curable compounds having the structure as set forth in claim 2, including, in particular, compounds, wherein when n = 1, Y = the group



Accordingly, withdrawal of the rejection of claims 1-8 as anticipated by Kobayashi is respectfully requested.

In order to remove the obviousness-type double patenting rejection based on the copending commonly assigned U.S. 6,245,829, a Terminal Disclaimer, together with the appropriate fee is submitted herewith.

Therefore, this rejection should be withdrawn.

A supplemental IDS which includes an English Abstract of JP 5 148 429 is enclosed. An English abstract of EP 0 525 601 is also being provided.

Accordingly, consideration of these documents is requested.

Finally, a certified copy of EP 98202239.4, filed 07/06/98 is being filed herewith in order to perfect applicants' claim for priority under 35 USC 119.

In view of the foregoing, the claims are now believed to be in form for allowance, and such action is hereby solicited. If any point remains in issue which the Examiner feels may be best resolved through a personal or telephone interview, please contact the undersigned at the telephone number listed below.

Attached is a marked-up version of the changes made to the specification and claims by the current amendment. The attached Appendix is captioned "Version with markings to show changes made".

All objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

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Enclosure: Appendix

APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE  
IN THE SPECIFICATION:

The specification is changed as follows:

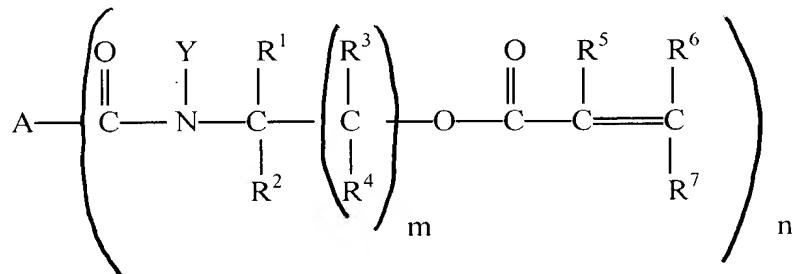
The paragraph on page 5, beginning on line 23, is amended as follows:

--In case the unsaturated esteramide functions as the crosslinker the binder composition further can comprise a binder polymer having generally an amount of polymerizable unsaturation – expressed as WPU – ranging from 145 to 3000 grams of polymer per mole of unsaturated group (WPU), and preferably from 300 to 2000 grams per mole of unsaturated group. The unsaturated groups may be positioned both within the chain and at the end of the chain.--

IN THE CLAIMS:

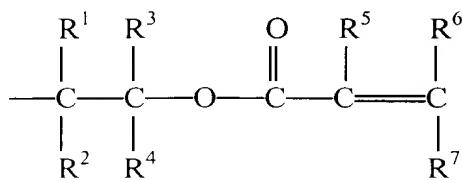
Claim 1 is cancelled.

2. (Amended) A radiation curable [composition according to Claim 1, characterized in that the] compound comprising a mono or multi valent carboxylic acid ester of a  $\beta$ ,  $\gamma$ ,  $\delta$  or  $\epsilon$ -hydroxy-alkylamide group containing compound, in which the carboxylic ester is derived from an  $\alpha$ ,  $\beta$ -ethylenically unsaturated carboxylic acid, wherein the radiation curable compound is a compound according to formula (I):



A = hydrogen, or a monovalent [op] or polyvalent organic group which is derived from a saturated or an unsaturated (C<sub>1</sub>-C<sub>60</sub>) alkyl, derived from an (C<sub>6</sub>-C<sub>10</sub>) aryl group, or a polymer P[.];

Y = hydrogen, an alkyl group having from 1 to 8 carbon atoms or



R<sup>1</sup>, R<sup>2</sup>, R<sup>3</sup>, R<sup>4</sup> are, identical or different, hydrogen or a [lineair] linear, branched or cyclic (C<sub>1</sub>-C<sub>8</sub>) alkyl chain,

R<sup>5</sup> = hydrogen, (C<sub>1</sub>-C<sub>5</sub>) alkyl, -CH<sub>2</sub>OH or CH<sub>2</sub>COOX,

R<sup>6</sup>, R<sup>7</sup> = hydrogen, (C<sub>1</sub>-C<sub>8</sub>) alkyl, (C<sub>6</sub>-C<sub>10</sub>) aryl or COOX,

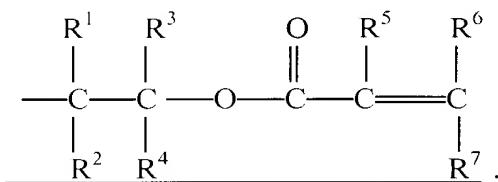
X = hydrogen or (C<sub>1</sub>-C<sub>8</sub>) alkyl,

n = 1-1000 and

m = 1-4,

with the proviso that when n = 1,

Y =



3. (Amended) [Composition according to any one of Claims 1 -2, characterized in that] Radiation curable compound according to claim 2, wherein Y is hydrogen or methyl and R<sup>1</sup>, R<sup>2</sup>, R<sup>3</sup> and R<sup>4</sup> are hydrogen or methyl.

Claims 9-25 are added.

End of Appendix